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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WARE, CICELY Q

ART UNIT	PAPER NUMBER
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2634

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DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,470

Applicant(s)

EDLIS ET AL.

Examiner

Cicely Ware

Art Unit

2634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - a. Pg. 7, lines 2-3, applicant uses the phrase "may be use to acquiring an analog". Examiner suggests applicant use "may be used to acquire an analog" for clarification purposes.

Appropriate correction is required.

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

3. Claims 1-19 are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Claim Rejections - 35 USC § 112

4. Claims 1, 5, 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1, 5, and 12 all recite the phrase "substantially simultaneously". "substantially simultaneously" is vague and indefinite. The phrase does not provide a definite boundary for the limitations of the claims.

b. Claim 10 recites "generally no reception". "generally" is vague and indefinite. It does not provide a definite boundary for the limitations of the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 8, 9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kornfeld et al. (US Patent 5,758,266). *in view of Hattinen*

(1) With regard to claim 1, Kornfeld et al. discloses a method comprising searching for a pilot signal of a second communication s system while being in communication with a first communications system (abstract, col. 1, lines 50-63, col. 2, lines 36-51).

(2) With regard to claim 2, claim 2 inherits all the limitations of claim 1. Kornfeld et al. further discloses searching comprising recording on-line a portion of signals received from said second communications system; and background processing said portion of signals to search for said pilot signal (col. 2, lines 17-51).

(3) With regard to claim 3, claim 3 inherits all the limitations of claim 2. Kornfeld et al. further discloses recording comprises recording a portion of spread spectrum signals and said processing comprises processing a portion of spread spectrum signals (col. 1, lines 38-53).

(4) With regard to claim 4, claim 4 inherits all the limitations of claim 3. Kornfeld et al. further discloses wherein said processing comprises performing Code Division Multiple Access (CDMA) acquisition (col. 1, lines 50-60).

(5) With regard to claim 5, claim 5 inherits all the limitations of claim 2. Kornfeld et al. further discloses wherein said recording and said processing comprise recording and processing a portion of CDMA signals while receiving RF signals at a different frequency on-line (abstract). *col 3 116-27 where's the line col 1*

(6) With regard to claim 8, claim 8 inherits all the limitations of claim 4. Kornfeld et al. further discloses wherein said performing of CDMA acquisition comprises finding a correlation between a pseudo-noise sequence of the recorded portion of CDMA signals and one of a plurality of known PN sequences (col. 1, lines 50-60, col. 2, lines 17-51).

(7) With regard to claim 9, claim 9 inherits all the limitations of claim 8. Kornfeld et al. further discloses shifting the PN of the CDMA signals (col. 1, lines 50-60).

(8) With regard to claim 12, Kornfeld et al. discloses a dual mode receiver comprising: a searcher adapted to search a pilot signal of a second communications system, while being in communication with a first communications system (abstract, col. 1, lines 50-63, col. 2, lines 36-51).

(9) With regard to claim 13, claim 13 inherits all the limitations of claim 12.

Kornfeld et al. further discloses a memory adapted for recording on-line a portion of signals received from said second communications system; and a background processing unit adapted to process a portion of signals to offline to search for said pilot signal (col. 2, lines 17-51).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6, 11 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kornfeld et al. (US Patent 5,758,266) as applied to claims 1, 5 and 13 above, in view of Vilmur (US Patent 5,950,131).

(1) With regard to claim 6, claim 6 inherits all the limitations of claim 5. However Kornfeld does not disclose wherein recording comprises recording said portion of CDMA signals after converting the portion of CDMA signals from an analog signal to a digital signal.

However Vilmur discloses a radiotelephone in a CDMA communication system wherein recording comprises recording a portion of CDMA signals after converting the portion of CDMA signals from an analog signal to a digital signal (Fig. 1 (112, 128), col. 5, lines 2-5, 29-52).

Therefore it would have been obvious to one of ordinary skill in the art to modify Kornfeld et al. to incorporate wherein recording comprises recording a portion of CDMA signals after converting the portion of CDMA signals from an analog signal to a digital signal for fast and accurate pilot searching (Vilmur col. 3, lines 31-32).

(2) With regard to claim 11, claim 11 inherits all the limitations of claim 1. Vilmur further discloses wherein communication signals from said first communications system comprise repetitions of sub-frames in data frame, and said searching comprises: recording on-line a portion of signals received from said second communications system during at least one said repetition of at least one said sub-frame in at least one said data frame (col. 4, lines 10-12, 60-65, col. 5, lines 39-50).

(3) With regard to claim 14, claim 14 inherits all the limitations of claim 13 above. Vilmur further discloses wherein said portion of signals comprises a portion of spread spectrum signals (col. 5, lines 39-43).

(4) With regard to claim 15, claim 15 inherits all the limitations of claim 13 above. Vilmur further discloses wherein said portion of signals comprises a portion of CDMA signals (col. 2, lines 21-22).

(5) With regard to claim 16, claim 16 inherits all the limitations of claim 15. Kornfeld et al. further discloses wherein said CDMA signals comprise a PN sequence (col. 1, lines 50-51).

(6) With regard to claim 17, claim 17 inherits all the limitations of claim 16. Kornfeld et al. further discloses wherein said background processing unit is adapted to

Art Unit: 2634

perform CDMA acquisition by processing said portion of CDMA signals offline (col. 2, lines 17-51).

(7) With regard to claim 18, claim 18 inherits all the limitations of claim 17.

Kornfeld et al. further discloses wherein said background processing unit is adapted to find a correlation between the PN sequence of said portion of CDMA signals and one of a plurality of known PN sequences (col. 1, lines 50-60, col. 2, lines 17-51).

(8) With regard to claim 19, claim 19 inherits all the limitations of claim 15.

Kornfeld et al. further discloses wherein said first and second communications systems comprise at least one of CDMA, Advanced Mobile Phone Service (AMPS), Frequency Division Multiple Access (FDMA), Time Division Multiple Access (TDMA), and Global Mobile System (GSM) communication systems (col. 1, lines 31-37, col. 2, lines 36-39).

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kornfeld et al. (US Patent 5,758,266) as applied to claim 5 above, in view of Rotstein et al. (US Patent 6,289,228).

With regard to claim 7, claim 7 inherits all the limitations of claim 5. However Kornfeld et al. does not disclose wherein said recording comprises recording said portion of CDMA signals after digitally processing the portion of CDMA signals.

However Rotstein et al. discloses a DS-CDMA communication system wherein recording comprises recording a portion of CDMA signals after digitally processing the portion of CDMA signals (Fig. 2 (110, 114, 116, 128), col. 7, lines 5-13).

Therefore it would have been obvious to one of ordinary skill in the art to modify Kornfeld et al. to incorporate wherein recording comprises recording a portion of CDMA signals after digitally processing the portion of CDMA signals so that it is unnecessary to monitor all the paging channels to detect paging activity (Rotstein et al. col. 7, lines 10-13).

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kornfeld et al. (US Patent 5,758,266) as applied to claim 1 above, in view of Rainish et al. (US Patent 6,606,490).

With regard to claim 10, claim 10 inherits all the limitations of claim 1. However Kornfeld et al. does not disclose said first communications system operates in a compressed mode of communication, said compressed mode comprising a gap period wherein there is no reception and transmission and said searching comprises: recording on-line a portion of signals received from said second communications system during said gap period.

However Rainish et al. discloses a direct sequence CDMA receiver wherein the first communications system operates in a compressed mode of communication, the compressed mode comprising a gap period wherein there is no reception and transmission and searching comprises: recording on-line a portion of signals received from the second communications system during the gap period (col. 1, lines 14-28).

Therefore it would have been obvious to one of ordinary skill in the art to modify Kornfeld et al. to incorporate wherein the first communications system operates in a

Art Unit: 2634

compressed mode of communication, the compressed mode comprising a gap period wherein there is no reception and transmission and searching comprises: recording on-line a portion of signals received from the second communications system during the gap period in order to save battery power in the communication system (Rainish et al. col. 1, lines 17-18).

Conclusion

11. The prior art made record of and not relied upon is considered pertinent to applicant's disclosure:

a. Dent US Patent 5,708,971 discloses a two-way paging system and apparatus.

b. Stahle US Patent 6,414,984 discloses a method for controlling a receiver and a receiver.

c. Gudmundson et al. US Patent discloses TDMA for mobile access in a CDMA system.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cicely Ware whose telephone number is 703-305-8326. The examiner can normally be reached on Monday – Friday, 8-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin can be reached on 703-305-4714. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Art Unit: 2634

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Cicely Ware

cqw
April 6, 2004



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SUPERVISORY PATENT EXAMINER
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